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PARIS**Date** December 14, 2005 **Client-Matter** 49298-043**Total Pages (Including Cover)** 9**From** Robert Mayer**Sender's Voice Number** 212.969.3246**Sender's Email Address** RMayer@proskauer.com**To:** Examiner Jonathan P. Ouellette**Company:** United States Patent & Trademark Office**Fax Transmittal****Sender's Room Number** 1632**Main Fax Number** 212.969.2900**Fax No.:** 571-273-8300**Voice No.:****Message**

In re the Application of:

Sundeep BHAN et al.

Application No.: 10/734,811

Filed: December 11, 2003

For: TARGETED INVITATION DELIVERY

Group Art Unit: 3629

Examiner: Ouellette, Jonathan P.

**NOTICE OF APPEAL AND
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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PTO/SB/21 (09-04)

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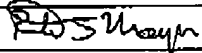
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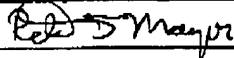
TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>	Application Number	10/734,811	
	Filing Date	December 11, 2003	
	First Named Inventor	Sundeeb Bhan	
	Art Unit	3629	
	Examiner Name	Jonathan P. OUELLETTE	
Total Number of Pages In This Submission	8	Attorney Docket Number	49298-043

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Documents <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): -Pre-Appeal Brief Request For Review -Remarks In Support Of Pre-Appeal Brief Request For Review (3 Pages)
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	PROSKAUER ROSE LLP		
Signature			
Printed Name	ROBERT S. MAYER		
Date	December 14, 2005	Reg. No.	38,544

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Robert S. Mayer	Date	December 14, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ **310.00**)**Complete if Known**

Application Number	10/734,811
Filing Date	December 11, 2003
First Named Inventor	Sundeep Bhan
Examiner Name	Jonathan P. OUELLETTE
Art Unit	3829
Attorney Docket No.	49298-043

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: _____

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For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☒ Credit any overpayments

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Small Entity Fee (\$)

Fee (\$)

Each independent claim over 3 (including Reissues)

Fee (\$)

Multiple dependent claims

Fee (\$)

Total Claims**Extra Claims****Fee (\$)****Fee Paid (\$)****Multiple Dependent Claims****Fee (\$)****Fee Paid (\$)**

- 20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims**Extra Claims****Fee (\$)****Fee Paid (\$)**

- 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets - 100 = **Extra Sheets** / 50 = **Number of each additional 50 or fraction thereof** (round up to a whole number) x **Fee (\$)** = **Fee Paid (\$)**

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: **Notice of Appeal=250.00; Petition for Extension of Time =60.00;****Fee Paid (\$)****310.00****SUBMITTED BY**

Signature



Registration No.

(Attorney/Agent) **38,544**

Telephone (212) 969-3246

Name (Print/Type)

Robert S. MayerDate **12/14/2005**

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 49298-043	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>DECEMBER 14, 2005</u> Signature <u>Robert S. Mayer</u> Typed or printed name <u>Robert S. Mayer</u>		Application Number <u>10/734,811</u>	Filed <u>December 11, 2003</u>
		First Named Inventor <u>Sundep BHAN et al.</u>	
		Art Unit <u>3629</u>	Examiner <u>Jonathan P. OUELLETTE</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <u>38,544</u> Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>Robert S. Mayer</u> Signature <u>Robert S. Mayer</u> Typed or printed name <u>(212) 969-3246</u> Telephone number <u>December 14, 2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application No. 10/734,811
Attorney Docket: 49298-043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sundeep BHAN et al.

Application No.: 10/734,811

Filed: December 11, 2003

For: TARGETED INVITATION DELIVERY

Group Art Unit: 3629

Examiner: Ouellette, Jonathan P.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

A Notice of Appeal and Pre-Appeal Brief Request for Review are filed herewith, and consideration of the remarks contained herein is respectfully requested under the "New Pre-Appeal Brief Conference Pilot Program" described in the OG Notice dated July 12, 2005. Although no additional fees are believed due in connection with this paper, the Commissioner is authorized to charge any required fees to Deposit Account No. 16-2500.

Application No. 10/734,811

The Advisory Action dated December 1, 2005, indicates that the amendments proposed in Applicant's Amendment After Final Rejection dated November 10, 2005, were not entered. Accordingly, the claims that are listed in Applicant's Amendment dated June 8, 2005, remain under consideration (i.e., claims 1-6, 8, 10-15, 17, and 18), and the Panel is referred to that paper for the complete text of the claims. Claims 1, 6, and 15 are independent.

All the claims stand rejected under 35 U.S.C. § 102 as anticipated by WO 01/52106 A2 (*Gal*). However, Applicant maintains that *Gal* does not teach or suggest the limitation in claims 1, 6, and 15 that requires a multi-event invitation to be sent via email.

Pursuant to ¶ 4 of the July 12, 2005, OG Notice, which encourages Applicants "to refer to arguments already of record rather than repeating them in the request," Applicant asks the panel to reconsider the arguments in the Amendment dated June 8, 2005 at pages 7 and 8.

In response to those arguments, the § 102 rejection was repeated in the Final Office Action dated August 15, 2005. More specifically, despite the fact that the invitation in *Gal* "is dynamically constructed" "when a user goes to the web page for the user's invitations" (*Gal* at p. 5, lines 18-20), and despite the explicit teaching in *Gal* that email should not be used for the invitations (*Gal* at p. 6, lines 1-6), the Final Office Action asserted that *Gal* satisfied the "email" limitation in claims 1, 6, and 15.

This rejection was based on defining email as "electronic communication through a computer." (Final Office Action dated August 15, 2005, at p. 5, ¶15.) However, use of that definition in rejecting the claims confuses the broad genus (i.e., electronic communication through a computer) with a particular species within that genus (i.e., email). As a result, the rejection is overreaching in that it goes beyond the plain meaning of the term "email," and

Application No. 10/734,811

applies a much broader meaning to that word. See M.P.E.P. § 2111.01. More specifically, the genus of "electronic communication through a computer" contains many types of communications other than emails (e.g., instant messages, VOIP voice communications, inter-computer Ethernet links, etc.). Since the scope of the claims is explicitly limited to email and does not extend to all types of electronic communication through a computer, the § 102 rejection was improper because it rejected a claim to a particular species (i.e., email) based on the broad genus containing that species (i.e., electronic communication through a computer).

Since *Gal* does not teach or suggest sending the multi-event invitation via email, as explained above and in the Amendment dated June 8, 2005 at pages 7 and 8, Applicant submits that claim 1, 6, and 15 are patentable over *Gal*.

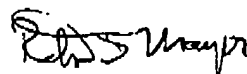
Applicant's undersigned attorney may be reached by telephone at (212) 969-3246 or by facsimile at (212) 969-2900. Please direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted,

PROSKAUER ROSE LLP

Date: December 14, 2005

By:



Robert S. Mayer
Attorney for Applicants
Registration No. 38,544

Proskauer Rose LLP
Patent Department
1585 Broadway
New York, NY 10036-8299
Tel. (212) 969-3246 (direct)
Fax (212) 969-2900